

REMARKS/ARGUMENTS

In response to the Office Action mailed October 19, 2005, Applicant amends his application and requests reconsideration. In this Amendment, claims 3, 12, and 13 are canceled and new claims 14-18 are added so that claims 1, 2, 4-11, and 14-18 are now pending.

Claim 11 was objected to as lacking antecedent basis for the term "the side parts". In fact, antecedent basis was provided for this term in claim 10. Perhaps the failure to recite exactly the same language as in claim 10 led to the claim objection. Claim 10 is amended for clarity and claim 11 is amended so that exactly the same term that appears in claim 10 is also recited in claim 11. Other claims have been amended as to form to ensure the recitation of the exact words in the claims to avoid issues of antecedent basis.

In this Amendment, claim 1 is amended for clarity and new claims 14-18 are added to describe aspects of the invention disclosed in the patent application but not previously an express part of the claims. Amended claim 1 clearly distinguishes as separate elements the enclosure and the thermally conductive enclosure part. Further, the enclosure is described as being located in the body as should have been apparent from the examined claim, interpreted in conjunction with the disclosure of the patent application. In the described embodiment, the enclosure 400 is clearly separate from the thermally conductive enclosure part 430 which closes the unnumbered open end of the enclosure 400. Figure 1 clearly shows that the enclosure 400 is disposed within the plastic body 100 of the power hand tool.

Newly added claim 14 describes the enclosure as substantially tubular as well as unitary. The patent application at page 7 describes the enclosure 400, referring to the enclosure as a capsule having portions 410 and 420. The end cap 430, corresponding to the enclosure part, forms a sealed enclosure enclosing the motor 200 and the gearbox 220. The capsule 400 is described as being plastic at page 6 of the patent application and as having an open-ended front portion as well as a closed-ended rear portion. These disclosures fully support amended claim 1 and also the added dependent claims, claims 14-18.

Examined claims 1-7 and 10-13 were rejected as anticipated by Armbruster et al. (GB 2,050,213, hereinafter Armbruster) and claims 8 and 9 were rejected as obvious over Armbruster considered by itself. These rejections are respectfully traversed.

The principal error in the rejection is the repeated use of identical elements of Armbruster to represent clearly different mechanical elements of the claimed invention. This repeated use of physical elements is prohibited and is unlike the use of a single physical element to fulfill different functional limitations of separately identified "means for" elements. For example, the Examiner considered the foam body 101 of Armbruster to be the same as the enclosure of the claimed power hand tool. This comparison was inaccurate as to

the examined claims because the foamed outer cover of Armbruster cannot function both as the body and the enclosure of the claimed invention. In order to avoid repetition of this error, amended claim 1 describes the enclosure as being located within the body. That arrangement is clearly not present in Armbruster.

In addition, the Examiner designated the shells 100 of Armbruster as both the thermally conductive enclosure of the claimed invention and as the thermal conductor extending the metal motor casing and the conductive enclosure part. This double use of the same element was improper in examining the presented claims because the thermally conducting enclosure part is a distinct element, distinct from both the enclosure and the thermal conductor. Because of these misinterpretations, which cannot be repeated in view of the clarification of claim 1, the rejection is fundamentally erroneous.

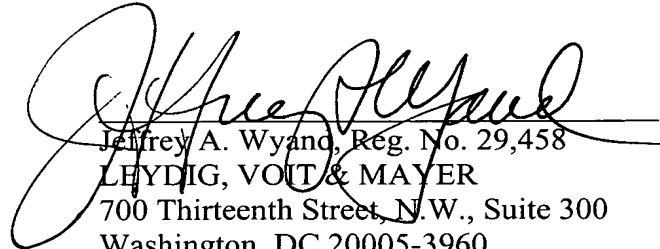
Further, the rejection cannot properly be repeated because there is no element within Armbruster that can correspond to the enclosure of the claimed invention which has an open end and that is clearly distinct from the thermally conductive enclosure part that engages and closes the open end of the enclosure. These differences alone overcome the rejection of all claims.

Likewise, the rejection of claim 2 is incorrect. The power hand tool according to claim 2 requires that the enclosure part be situated outside the body. The Examiner considered the enclosure part of Armbruster to be the shell 100 and the body to be the foam material 101. While, at the air vents, the shell 100 in Armbruster may be flush with the surface of the foam body 101, the shell 100 is never outside the foam body as in the structure of claim 2. Finally, with regard to the newly added dependent claims 14-18, there are no parts within the Armbruster structure that can correspond to any of the limitations expressed in those claims.

The double inclusion that illustrates the flaws in the rejection of claim 1 likewise affects numerous dependent claims, considered separately from claim 1, such as, but not limited to, claims 7, 10, and 11. However, because claim 1 clearly distinguishes the invention from Armbruster, further discussion of those dependent claims is neither necessary nor provided.

Reconsideration and allowance of all of the claims now presented are respectfully requested.

Respectfully submitted,


Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date:
JAW/jj

